

TTAB

Fredrikson

& BYRON, P.A.

May 16, 2005

VIA U.S. MAIL

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
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I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail, postage prepaid, and in an envelope addressed to the Trademark Trial and Appeal Board, United States Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, on	
<u>5/16/05</u>	<u>Molly O'Brien Loussaert</u>
Date	Signature

Re: Medtronic, Inc. and Pacesetter, Inc. d/b/a St. Jude Medical Cardiac
Rhythm Management Division v. Cardiac Pacemakers, Inc.
Opposition No. 91163746



05-19-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

Dear Sir or Madam:

Enclosed for filing with your office, please find Medtronic, Inc.'s Reply in Support of Its Clarification to Joint Submission and Stipulation and Request to Amend Order to Dismiss PACERPLUS Application Serial No. 76/535,841 (Opposition No. 91163746) With Prejudice in regard to the above-referenced matter.

By copy of this letter, opposing counsel is served.

Sincerely,

Molly Loussaert
Attorney at Law
Direct Dial: 612.492.7308
Email: mloussaert@fredlaw.com

MOL/dlo/3120795
Enclosure

cc: James T. Nikolai, Esq.
Thomas Berry, Esq.
Steven M. Mitchell, Esq.

Attorneys & Advisors
main 612.492.7000
fax 612.492.7077
www.fredlaw.com

Fredrikson & Byron, P.A.
200 South Sixth Street, Suite 4000
Minneapolis, Minnesota
55402-1425

In the Matter of Trademark Serial No's. 76/535,842, 76/535,841, 76/535,840, and 76/536,437
For the Marks: PACERMAKERPLUS, PACERPLUS, PACER+ and PACEMAKER+

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Medtronic, Inc.,

Opposer,

Opposition No. 91161441

Opposition No. 91161444

Opposition No. 91161204

v.

Cardiac Pacemakers, Inc.,

Applicant



05-19-2005

U.S. Patent & TMOc/TM Mail Rcpt Dt. #11

Pacesetter, Inc. d/b/a St. Jude Medical
Cardiac Rhythm Management Division,

Opposer,

Opposition No. 91161301

Opposition No. 91162106

Opposition No. 91161126

v.

Cardiac Pacemakers, Inc.,

Applicant.

Medtronic, Inc., and Pacesetter, Inc.
d/b/a St. Jude Medical
Cardiac Rhythm Management Division,
Opposer,

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5/16/05
Date

Signature

**MEDTRONIC, INC.'S REPLY IN SUPPORT OF ITS CLARIFICATION TO JOINT
SUBMISSION AND STIPULATION AND REQUEST TO AMEND ORDER TO DISMISS
PACERPLUS APPLICATION SERIAL NO. 76/535,841
(OPPOSITION NO. 91163746) WITH PREJUDICE**

Contrary to the Applicant's assertions, the parties intended that Applicant's abandonment of the application in question was without Medtronic, Inc.'s consent. This is apparent in two ways.

First, the wording of the Joint Submission and Stipulation alone reveals that Medtronic, Inc. did not consent to the abandonment in question. When the parties jointly agreed to the provisions of a particular paragraph, the paragraph specifically states that it is "*the parties*" intention. For example, the first paragraph on page two states: "the parties request . . ."; the fourth paragraph states "the parties wish to note . . ."; the next paragraph states, "the parties agree . . ."; and the first paragraph on page three states, "the parties further stipulate and agree . . .". Notably, however, the provision now at issue makes no reference to "the parties." Rather, the provision only refers to "the applicant" as the sole actor. Thus, the terms of the Joint Submission and Stipulation itself reveal that Medtronic, Inc. did not consent to Applicant's abandonment of its application.

Second, the documents the parties exchanged prior to submitting the final draft of the Joint Submission and Stipulation clearly evidence the parties' intent. On February 15, 2005, Applicant emailed a draft of the Joint Submission and Stipulation to Medtronic, Inc.'s counsel. See Exhibit 1 to the Declaration of Lora Esch Mitchell ("Mitchell Decl."). Upon receipt, Medtronic, Inc.'s counsel revised the draft, executed it, and returned it to Applicant for execution and filing. See Mitchell Decl., ¶ 2, 3 and Exhibits 1-3. A comparison of the two documents reveals the changes Medtronic, Inc. made to the relevant third paragraph on page two of the Joint Submission and Stipulation *to which Applicant agreed*. Applicant's proposed language is set forth below in its entirety together with Medtronic, Inc.'s edits:

In view of the foregoing, applicant, ~~with the consent of the Opposers as indicated by the signature of their attorneys provided below~~, expressly abandons the **PACERPLUS (Application Serial No. 76/535,841)**; PACER+ (Application Serial No. 76/535,840) and PACEMAKER+ (Application Serial No. 76/536,437) applications. ~~The parties request that the oppositions related to the applications therefore be dismissed.~~

(emphasis added.) Because the final version of the Joint Submission and Stipulation incorporated Medtronic, Inc.'s edits, it is clear that the parties specifically agreed that Medtronic, Inc. did not consent to Applicant's abandonment of Application Serial No. 76/535,841. Moreover, it is equally clear that Applicant specifically understood and knew that its abandonment of the application in question would result in its dismissal with prejudice.

For all the forgoing reasons and those set forth in Medtronic, Inc.'s initial brief, the above-referenced application should be dismissed with prejudice.

Dated: May 16, 2005

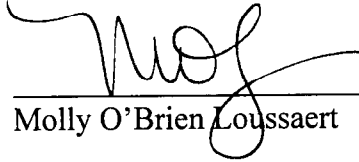


Dean R. Karau
Lora Esch Mitchell
Molly O'Brien Loussaert
FREDRIKSON & BYRON, P.A.
Suite 4000
200 So. 6th Street
Minneapolis, MN 55402-1425
Tel.: (612) 492-7000
Fax: (612) 492-7077

Attorneys for Opposer Medtronic, Inc.

Certificate of Service

I hereby certify that a true copy of MEDTRONIC, INC.'S REPLY IN SUPPORT OF ITS CLARIFICATION TO JOINT SUBMISSION AND STIPULATION AND REQUEST TO AMEND ORDER TO DISMISS PACERPLUS APPLICATION SERIAL NO. 76/535,841 (OPPOSITION NO. 91163746) WITH PREJUDICE AND DECLARATION OF LORA ESCH MITCHELL was served by United States mail on the attorney of record for Applicant in this action, Mr. James T. Nikolai , Nikolai & Mersereau, P.A., 820 International Centre, 900 Second Avenue So., Minneapolis, Minnesota, 55402, by mailing it to address of record by first class mail, postage prepaid, this 6 day of May, 2005.



Molly O'Brien Loussaert

#3120335\1

In the Matter of Trademark Serial No's. 76/535,842, 76/535,841, 76/535,840, and 76/536,437
For the Marks: PACERMAKERPLUS, PACERPLUS, PACER+ and PACEMAKER+

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Medtronic, Inc.,

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Opposition No. 91161441

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v.

Opposition No. 91161204

Cardiac Pacemakers, Inc.,

Applicant



05-19-2005

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #11

Pacesetter, Inc. d/b/a St. Jude Medical
Cardiac Rhythm Management Division,

Opposer,

Opposition No. 91161301

Opposition No. 91162106

v.

Opposition No. 91161126

Cardiac Pacemakers, Inc.,

Applicant.

Medtronic, Inc., and Pacesetter, Inc.
d/b/a St. Jude Medical
Cardiac Rhythm Management Division,
Opposer,

Opposition No. 91163746

v.

Cardiac Pacemakers, Inc.,

Applicant.

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Molly O'Brien Loussaert

5/19/05
Date

Signature

DECLARATION OF LORA ESCH MITCHELL

I, Lora Esch Mitchell, declare as follows:

1. I am a shareholder attorney with the law firm of Fredrikson & Byron, P.A., attorneys for Medtronic, Inc. in the above-captioned matter.

2. Attached hereto as Exhibit 1 is a true and correct copy of an email dated February 15, 2005 from Mr. Jim Nikolai, counsel for Applicant, Cardiac Pacemakers, Inc., to me, and the referenced draft Joint Submission and Stipulation.

3. I edited the draft Joint Submission and Stipulation by making handwritten edits which were incorporated in the draft I sent to Mr. Nikolai for signature and filing as evidenced by my letter to him dated February 17, 2005, a true and correct copy of which is attached hereto as Exhibit 2.

4. Attached hereto as Exhibit 3 is a true and correct copy of the final version of the Joint Submission and Stipulation Mr. Nikolai, counsel for Applicant, submitted to the Trademark Trial and Appeal Board on or about March 4, 2005.

Dated: May 15, 2005


Lora Esch Mitchell

#3118938\1

Mitchell, Lora Esch

From: JIM NIKOLAI [JIM@nm-iplaw.com]
Sent: Tuesday, February 15, 2005 2:44 PM
To: Mitchell, Lora Esch
Subject: Re: stipulation to consolidate



Joint
Submission.doc

Hi Lora,

As a follow-up to the discussion we had last week, I prepared the attached joint submission and stipulation. Please review and provide me with your comments.

I look forward to hearing from you.

Jim Nikolai
Nikolai and Mersereau, P.A.
820 International Centre
900 Second Avenue South
Minneapolis, MN 55402
(612) 339-7461

>>> "Mitchell, Lora Esch" <l Mitchell@fredlaw.com> 12/14/2004 10:21:17 AM >>>

Jim -- Attached is the stipulation we discussed to consolidate the Medtronic and St. Jude cases involving PACEMAKERPLUS. Sorry it has taken me a while to get this to you. Please let me know if you have any comments.
Lora
<<1TBCM01!.DOC>>

EXHIBIT

1

A handwritten signature, possibly 'L. Esch', enclosed in a circle.

In the Matter of Trademark Serial No's. 76/535,842, 76/535,841, 76/535,840, and 76/536,437
For the Marks: PACERMAKERPLUS, PACERPLUS, PACER+ and PACEMAKER+

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Medtronic, Inc.,

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v.

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Applicant

Pacesetter, Inc. dba St. Jude Medical
Cardiac Rhythm Management Division,

Opposer,

Opposition No. 91161301

Opposition No. 91162106

v.

Opposition No. 91161126

Cardiac Pacemakers, Inc.,

Applicant.

d/b/a Medtronic, Inc., and Pacesetter, Inc.

~~D/B/A~~ St. Jude Medical

Cardiac Rhythm Management Division,

Opposer,

Opposition No. 91163746

v.

Cardiac Pacemakers, Inc.,

Applicant.

JOINT SUBMISSION AND STIPULATION

This joint submission and stipulation is submitted in response to the paper mailed on February 7, 2005. Upon receipt of this paper, the undersigned discovered that there was a typographical error in the "Stipulated Motion to Consolidate Proceedings". The undersigned each apologize for the error and submits this joint submission to correct the error.

First, the parties request consolidation of the two oppositions that have been filed against application Serial No. 76/535,842 for the mark PACEMAKERPLUS. The numbers of these oppositions are 911614441 (filed by Medtronic) and 91161301 (filed by Pacesetter, Inc. doing business as St. Jude Medical Cardiac Rhythm Management Division).

Second, the applicant no longer has a *bona fide* intent to use the marks:

1. PACERPLUS (Application Serial No. 76/535,841) which is the subject of Opposition No. 91163746 filed jointly by Medtronic, Inc. and Pacesetter, Inc.
2. PACER+ (application Serial No. 76/535,840) which is the subject of Opposition No. 91161444 filed by Medtronic, Inc. and Opposition No. 91162106 filed by Pacesetter, Inc.
3. PACEMAKER+ (Application Serial No. 76/536,437) which is the subject of Opposition No. 91161126 filed by Pacesetter, Inc. and 91161204 filed by Medtronic.

In view of the foregoing, applicant, ~~with the consent of the Opposers as indicated by the~~
~~signature of their attorneys provided below,~~ expressly abandons the PACERPLUS (Application
Serial No. 76/535,841); PACER+ (Application Serial No. 76/76/535,840) and PACEMAKER+
(Application Serial No. 76/536,437) applications. ~~The parties request that the oppositions related~~
~~to the applications therefore be dismissed.~~

Third, the parties wish to note that answers have been filed in connection with the two oppositions that remain (i.e., Opposition Nos. 91161441 and 91161301) related to the PACEMAKERPLUS application.

Fourth, the parties agree that Opposition Nos. 91161441 and 91161301 involve common questions of law and fact. Medtronic and St. Jude have both opposed Applicant's application to

register PACEMAKERPLUS on the same grounds, i.e. alleging that the mark is a generic term and/or merely descriptive. The parties also agree that consolidation of these proceedings will save time, effort, and expense. Accordingly, the parties request that the Board consolidate the actions.

The parties further stipulate and agree that the Board should adopt the following discovery, testimony and briefing dates in the consolidated case:

Discovery period to close:

May 2, 2005

August 1, 2005
Bump out?

30-day testimony period for party
in position of plaintiff to close:

August 1, 2005

N

30-day testimony period for party
In position of defendant to close:

October 3, 2005

Dec.

15-day rebuttal testimony period
for plaintiff to close:

November 15, 2005

Dated: _____, 2005

Dean R. Karau
Lora Esch Mitchell
FREDRIKSON & BYRON, P.A.
Suite 4000
200 So. 6th Street
Minneapolis, MN 55402-1425
Tel.: (612) 492-7000
Fax: (612) 492-7077

Attorneys for Opposers Medtronic, Inc.
and Pacesetter, Inc.

*Want to
draw line in
sand?*

Dated: _____, 2005

James T. Nikolai
Nikolai & Mersereau, P.A.
820 International Centre
900 Second Avenue So.
Minneapolis, MN 55402
Tel.: (612) 339-7461
Fax: (612) 349-6556

Attorneys for Applicant

SO ORDERED:

Dated: _____, 2005

February 17, 2005

James T. Nikolai, Esq.
Nikolai & Mersereau, P.A.
820 International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402

Re: In the Matter of Trademark Serial No. 76/535,842
For the Mark: PACEMAKERPLUS
Medtronic, Inc. v. Cardiac Pacemakers, Inc. (Opposition No. 91161441)
Pacesetter, Inc., d/b/a St. Jude Medical Cardiac Rhythm Management Division v. Cardiac
Pacemakers, Inc. (Opposition No. 91161301)

Dear Mr. Nikolai:

Enclosed is the Joint Submission and Stipulation in connection with the above matter that has been signed on behalf of Medtronic and Pacesetter.

Sincerely,



Lora Esch Mitchell

Attorney

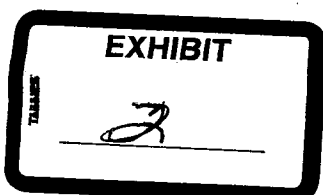
Direct Dial: 612.492.7185

Email: lmitchell@fredlaw.com

/mp/3082161

Enclosure

cc: Thomas Berry (w/ enclosure)
Steven M. Mitchell, Esq. (w/ enclosure)
Dean R. Karau, Esq. (w/ enclosure)



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TEL: (612) 338-1111
FAX: (612) 338-1112

March 4, 2005

Box TTAB
Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451


Re: Opposition Nos. 91161441; 91161444; 91161204; 91161301;
911662106; 91161126; 91163746
Medtronic and Pacesetter, Inc. v. Cardiac Pacemakers, Inc.
Our File No. 20050111.LAW

Dear Sir/Madam:

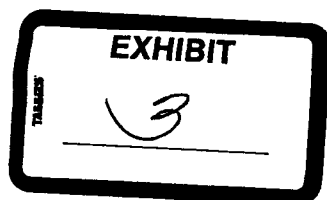
Enclosed for filing in the above-noted opposition
proceedings is a Joint Submission and Stipulation.

Sincerely,

NIKOLAI & MERSEREAU, P.A.


James T. Nikolai

JTN:br
Enclosure
cc: Lora Esch Mitchell, Esq. ✓



2

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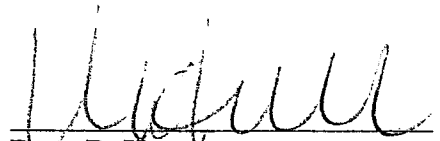
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• save time, effort, and expense. Accordingly, the parties request that the Board consolidate the actions.

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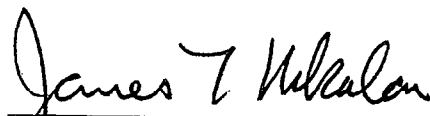
Dated: Feb. 16, 2005



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Attorneys for Opposers Medtronic, Inc.
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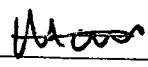
Dated: March 1, 2005



James T. Nikolai
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820 International Centre
900 Second Avenue So.
Minneapolis, MN 55402
Tel.: (612) 339-7461
Fax: (612) 349-6556

Attorneys for Applicant

SO ORDERED:

Dated: , 2005

#3081658\1